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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,575	08/06/2002	Sydney Gordon Low	DAVI147.001APC	1720

20995 7590 09/28/2006		EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP		CORRIELUS, JEAN M	
2040 MAIN STREET			
FOURTEENTH FLOOR	ART UNIT		PAPER NUMBER
IRVINE, CA 92614	2162		

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	10/009,575	LOW ET AL.
Office Action Summary	Examiner	Art Unit	
	Jean M. Corrielus	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
> - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
> - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 August 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>19-36</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>19-36</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is in response to the Request for Continued Examination (RCE) filed

on August 24, 2006, in which claims 19-36 are presented for further examination.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on August 6, 2006 has been entered.

Information Disclosure Statement

3.   The information disclosure statement (IDS) filed on August 24, 2006 and April 18, 2006

complies with the provisions of M.P.E.P 609. It has been placed in the application file. The

information referred to therein has been considered as to the merits.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   This application currently names joint inventors. In considering patentability of the

claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6.   Claims 19-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier US

Patent no. 6,480,885 and Ogilvie et al., (hereinafter "Ogilvie") US Patent no.6,324,569.

As to claim 19, Olivier discloses an analogous system that enables users to exchange group

electronic mail by establishing profiles and criteria for determining personalized subsets within a

group by comparing the identified appearing on the allowed list to determine whether each

designated recipient is on the list for the intended recipient that stored on the database of the e-

mail manager (col.17, lines 7-12). In particular, Olivier stated that if the message is not

approved, the sender is notified by the system (col.14, line 56-col.15, line 15). Although, Olivier

does not explicitly discloses the use of notifying the recipient if a message is unapproved.

Olivier, however, stated when someone responds to a message via their email client's reply all

feature, the message is addressed back to that to header field, including the encoded unique ID is

extracted from the email address and it then uses the stored distribution list associated with the

unique ID, rather than the sender's distribution list, so the system would automatically checking

the recipient's message acceptance and unapproval criteria data. Olivier also allows the sender to

modify the setting when sending a message. Such teaching of Olivier has the functional

limitation of sending a notification to the recipient when a message is unapproved with respect to

the message criteria data set by the sender. Once the notification is set by Olivier in the message

criteria data, the recipient will automatically receives an acknowledgement as to whether a

message is approved or not (see Olivier col.16, lines 25-62). Ogilvie, on the other hand,

discloses an analogous system for "notifying the recipient if a message is unapproved" as a

means of providing the recipient with the capability to manage unsolicited email messages

without the messages inadvertently removed by a message filter, and also requesting to remove

from the mailing list (col.1, lines 55-64; col.14, lines 26-39). The system of Ogilvie has the

capability, both, of not requiring that recipients affirmatively remove unwanted email or create a

reply message having remove in the subject to indicate their lack of interest in the subject matter

(col.11, lines 1-6) and determining whether they contain any self removing message indicators

from message originators then automatically notifying the recipient according to the instruction

of the replacement message (col.13, lines 1-5; col.14, lines 28-39). Therefore, it would have been

obvious to one of ordinary skill in the art of data processing, at the time the present invention

was made to combine the teachings of the cited references, wherein the message distribution

provided therein (See Olivier's fig.10 (2)) would incorporate the use of notifying the recipient if

the message is unapproved (unsolicited), in the same conventional manner as disclosed by

Ogilvie (col.1, lines 55-64; col.13, lines 1-5; col.14, lines 28-39). One having ordinary skill in the art would have been motivated to utilize such a combination would provide Olivier's system the enhanced capability of managing unsolicited email messages without the messages inadvertently removed by a message filter, thereby reducing the inconvenience of unsolicited email by making it possible for officials to present messages that do not have to be manually removed by the recipient.

As claim 20, Olivier and Ogilvie disclose substantially the invention as claimed. In addition Ogilvie discloses the claimed "allowing the recipient to view an unapproved message" as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39).

As to claim 21, Olivier and Ogilvie disclose substantially the invention as claimed. Olivier, however does not explicitly disclose the claimed notifying the recipient with a notification message having a link to network data representing a list of unapproved. Ogilvie, on the other hand, discloses an analogous system for providing email message originator and distributors with default control over message removal at a message recipient's location, regardless of whether the message has been opened. In particular, Ogilvie discloses the claimed feature "notifying the recipient if a message is unapproved" as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39).

Ogilvie, also transfers the burden from the recipient to the system by automatically removing

unsolicited email message before or after being displayed. The system of Ogilvie has the

capability, both, of not requiring that recipients affirmatively remove unwanted email or create a

reply message having remove in the subject to indicate their lack of interest in the subject matter

(col.11, lines 1-6) and determining whether they contain any self removing message indicators

from message originators then automatically notifying the recipient according to the instruction

of the replacement message (col.13, lines 1-5; col.14, lines 28-39). Therefore, it would have been

obvious to one of ordinary skill in the art of data processing, at the time the present invention

was made to combine the teachings of the cited references, wherein the message distribution

provided therein (See Olivier's fig.10(2)) would incorporate the use of notifying the recipient if

the message is unapproved.(unsolicited), in the same conventional manner as disclosed by

Ogilvie (col.1, lines 55-64; col.13, lines 1-5; col.14, lines 28-39). One having ordinary skill in

the art would have been motivated to utilize such a combination would provide Olivier's system

the enhanced capability of managing unsolicited email messages without the messages

inadvertently removed by a message filter, thereby reducing the inconvenience of unsolicited

email by making it possible for officials to present messages that do not have to be manually

removed by the recipient.

As to claim 22, Since Olivier discloses a web browser plug-ins and other new technology that

allow the exchanged messages to be stored somewhere other than the currently viewed web site,

retrieve messages from the independent data store and displayed to the user and use an address of

a specific page being viewed within the web site (col.25, lines 25-41), the claimed wherein the

network data comprises markup language data accessible by a computer device of the recipient is met.

As to claim 23, Olivier discloses the claimed allowing the recipient to set criteria to determine if the message is approved (col.14, line 55-col.16, line 15; col.17, lines 7-21).

As to claim 24, Olivier discloses the claimed wherein the criteria include a sender of the message being on a stored approved list for the recipient (col.14, line 55-col.16, line 15; col.17, lines 7-21).

As to claim 25, Olivier discloses the claimed allowing the recipient to change the criteria (col.17, line 65-col.18, line 4).

As to claims 26-27, Olivier discloses the claimed notifying a sender of the unapproved message of deletion of the unapproved message (col.14, lines 56-58; col.15, lines 4-14).

As to claim 28, Olivier discloses the claimed wherein the message and the criteria are stored on an electronic message server (col.5, lines 5-45).

As to claims 29-32:

Claims 29-32 are computer system performing by the method of claims 19-28 above. They are, therefore, under the same rationale. In addition, Ogilvie discloses the use of storing and sending a notification to the recipient of unapproved message (col.1, lines 46-53); an access server for generating a display page with a list of unapproved message (col.5, lines 6-45); wherein the list of unapproved messages includes links to the unapproved message respectively and which on selection causes transmission of an unapproved message to a recipient's computer device for viewing by the recipient" (col.1, lines 55-65; col.14, line 26-38).

As to claim 33, Olivier discloses the claimed wherein the criteria include the sender of a message being on an approved list for the recipient stored on the system (col.14, line 55-col.15, line 15).

As to claims 34-35, Olivier discloses the claimed wherein the display page includes a link to at least one display page for displaying and changing the criteria ((col.17, line 65-col.18, line 4).
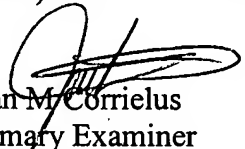
Conclusion

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jean M. Corrielus
Primary Examiner
Art Unit 2162

September 22, 2006